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10/015,980	12/13/2001	Fern Nee Tan	42P13112	6913

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EXAMINER

NGUYEN, VINH P

ART UNIT PAPER NUMBER

2829

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/015,980

Applicant(s)

TAN ET AL.

Examiner

VINH P NGUYEN

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 23-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

1. Claims 25-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 1003.

2. Examiner agrees with Applicants that only claim 1 is generic to both species of figures 2 and 3.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

4. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it appears that the limitation of “conductive material defining at least one wall of a well to receive a device under test” is inaccurate because the conductive material (222) does not receive a device under test but the nonconductive material (224).

In claim 13, it is unclear what “a gap” represents. Is it shown in any of drawings?

In claim 14, it is unclear what “a gap” represents. Is it shown in any of drawings?

In claim 15, it appears that the limitation of “the embedded conductive material defining at least one wall of a well to receive a device under test” is inaccurate because the conductive material (222) does not receive a device under test but the nonconductive material (224).

In claim 16, it is unclear whether a plurality of blocks of conductive material is different from the conductive material as recited in claim 1. Furthermore, it is unclear what “spaces”

represent. Are they shown in any of drawings?

The dependent claims not specifically address share the same indefiniteness as they depend from rejected base claims.

5. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It appears that the limitation of “conductive material defining at least one wall of a well to receive a device under test” as recited in claim 1 and the limitation of “the embedded conductive material defining at least one wall of a well to receive a device under test” as recited in claims 1 and 15 respectively do not have sufficient support in the elected species of figure 3 because the conductive material (222) does not receive a device under test but the nonconductive material (224).

The dependent claims not specifically address share the same indefiniteness as they depend from rejected base claims.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 (insofar as understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Takamine (pat # 4,825,155) .

As to claim 1, Takamine disclose in figure 4 an apparatus for testing an integrated circuit (54,56) having a conductive material (16), a non conductive material (12) covering the conductive material (16) and at least one electrical contact (34) extending from the conductive material (16) to be electrically coupled to a ground plane (30).

As to claim 2, Takamie also discloses a base layer (14) for supporting the conductive layer (16),

As to claim 3, it appears that the base layer (14) defines a floor of the well (50).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wu et al (Pat # 6,127,833) disclose test carrier for attaching a semiconductor device.

Maruyama (Pat # 5,828,224) discloses a test carrier for semiconductor for integrated circuit and method of testing semiconductor integrated circuit.

Ping et al (pat # 5,659,245) disclose ESD bypass and EMI shielding track design in burn-in board.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VINH P. NGUYEN whose telephone number is (703) 305-4914.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4900 .



VINH P. NGUYEN  
PRIMARY EXAMINER  
ART UNIT 2829

12/15/2003